

REMARKS

Claims 1 through 31 are currently pending in the application.

Claims 1 through 19 have been withdrawn from consideration as being directed to a non-elected invention.

Claims 20 through 31 currently stand rejected.

35 U.S.C. § 112, Second Paragraph

Claims 20 through 31 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended the claimed invention to particularly point out and distinctly claim the subject matter of the invention to comply with the provisions of 35 U.S.C. § 112, second paragraph. Therefore, presently amended claims 20 through 31 are allowable under the provisions of 35 U.S.C. § 112.

35 U.S.C. § 101, Statutory Double Patenting

Claims 20, 24, 25, 28, and 31 were rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 2, 6, 7, 10 and 13 of prior U.S. Patent 6,277,673 (hereinafter referred to as the '673 patent).

Applicant submits that a reliable test for statutory double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting under 35 U.S.C. § 101 does not exist. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

In the present instance, the embodiment of the invention set forth in amended independent claim 20 clearly sets forth an embodiment of the invention having elements of the

invention calling for "forming said second plurality of lead fingers having portions thereof extending below the bottom inactive surface of the semiconductor device and having portions thereof extending in the first horizontal plane of said active surface of said semiconductor device, said second plurality of lead fingers having portions extending substantially inwardly and extending downwardly from said first horizontal plane of the active surface a the semiconductor device placing portions of said lead fingers in a second substantially horizontal plane for providing a support surface for portions of said inactive surface of said semiconductor device, each lead finger of the second plurality of lead fingers having a portion thereof extending adjacent an end of the two opposed ends of the semiconductor device and terminating in an end located adjacent a peripheral side of the two opposed peripheral sides of the semiconductor device, at least one lead finger of the second plurality of lead fingers including a section extending substantially in the first horizontal plane" and "forming a die paddle for attaching portions of said inactive surface of said semiconductor device" whereas none of the embodiments of the claimed inventions of claims 2, 6, 7, 10, and 13 of the '673 patent have such elements of the inventions. Accordingly, no statutory double patenting under 35 U.S.C. § 101 can exist between presently amended independent claim 20 and dependent claims 21 through 30 of the present application and claims 2, 6, 7, 10, and 13 of the '673 patent. Therefore, claims 20 through 31 are allowable.

35 U.S.C. § 101, Obviousness-Type Double Patenting

Claims 21 through 23, 26, 27, 29 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 through 5, 8, 9, 11 and 12 of U.S. Patent 6,277,673 in view of U.S. Patent 5,541,446 to Kierse. In order to avoid further expenses and time delay, Applicant elects to expedite the prosecution of the present application by filing a terminal disclaimer to obviate the double patenting rejection in compliance with 37 C.F.R. §1.321 (b) and (c). Applicant's filing of the terminal disclaimer should not be construed

as acquiescence of the Examiner's double patenting or obviousness-type double patenting rejection. Attached is the terminal disclaimer and accompanying fee.

CONCLUSION

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicant has amended the claimed invention to clearly distinguish over the cited prior art.

Applicant submits that claims 20 through 31 are clearly allowable over the cited prior art.

Applicant requests the allowance of claims 20 through 31 and the case passed for issue.

Respectfully submitted,



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